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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,570	08/14/2000	Roger William Gutwein	7721M	9947

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/638,570	GUTWEIN ET AL.	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stover (U.S. Patent No. 4,579,048).

Stover discloses a system for preparing a customized brewed coffee beverage comprising structure allowing for delaying dilution of an extract (coffee, tea, etc.) for a time (e.g. 8 minutes; see coffee reference at col. 1, lines 16-19).

The following should be noted with regard to the particular brew solids content of the extract used. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 136 USPQ 458, 459 (CCPA 1963).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Adler.

Adler discloses a vending machine which provides a choice of drinks to be chosen by the consumer including coffee, coffee with cream, coffee with sugar, etc (col. 2, lines 45-52). The vending machine of Adler houses is disclosed to hold coffee in the form of a concentrate (Applicants own specification describes the extract used as a "concentrate" , page 11, second paragraph) wherein said concentrate is diluted the hot water when a coin is inserted into the machine and a choice of coffee beverage is made. Adler's invention is concerned with preserving the liquid coffee and other ingredients of the vending machine by using vacuum storage and wherein "materials may be kept in the machine over extended periods of time" (col. 2, lines 18 and 19). Although not specifying a particular time, it is considered inherent that "extended period of time" would be well beyond a 5 minute (or even 30 minute) interval of storage and that the apparatus of Adler would be able to perform in such manner.

The following should be noted with regard to the use of a brew extract, specifically, and the particular brew solids content of the extract used. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al.

If it is shown that by "extended time", Adler et al is referring to an apparatus which is only operates at a time range of less than 5 minutes, it would have been obvious to one having ordinary skill in the art to have modified the apparatus of Adler et al to allow same to be able to provide that said "extended period of time" would be over 5-30 minutes of time, since 5-30 minutes or less storage would be counter-productive to Adler's suggested money-saving apparatus which uses vacuum storage for preservation of the stored ingredients for a longer time than that employed in the prior art.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stover.

Stover is silent regarding the use of 15 or 30 minutes as a minimum for delay prior to dilution. Stover sets forth a typical delay of 8 minutes in a brewing operation. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the brewer

apparatus of Stover such that it is capable of waiting at least 15 or 30 minutes from the onset of brewing to begin dilution as a matter of preference depending on the time available to the consumer, to time same with other events or tasks, etc.

6. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive.

Applicant argues that Stover does not teach or claim Applicants' system-contained individual customization and that the dilution means lacks customer's input. The Examiner disagrees in so much as to how the instant claims are presented. The instant claims call for a system or apparatus for preparing an individually customized coffee beverage which has the ability to include coffee extract of a certain brew solids percent and wherein the apparatus has the capacity to delay a certain action (dilution, mixing, or filtering) after onset of brewing of the extract. Stover discloses an apparatus which has the capacity to be used for customizing individual quantities of coffee in certain respects. Certainly the substrate used for brewing may be changed in the apparatus. Also, Stover specifically discloses at least one other aspect of customizing. That is, "the quantity of dilution water may be varied so as to vary the strength of the beverage produced..." (i.e. beverage strength, paragraph bridging columns 6 and 7). Stover later describes the apparatus having a "delay dial" or "dilution dial" which is adjusted to provide the user (i.e. customer) a preferred product regarding the strength/dilution of same (paragraph bridging columns 8 and 9). Stover further discloses said apparatus possessing a control thermostat for adjusting the temperature of the dilution water to be used, thus another control feature for customizing the coffee product (col. 9, lines 3-7).

Stover clearly teaches an apparatus which allows for the preparation of a customized coffee product. Stover does not teach way from an apparatus having the capability for preparing a customized coffee.

Applicants further argue that Stover does not teach the particular method for brewing coffee. Applicants are reminded, however, that the instant claims refer to a system or apparatus for preparing coffee and not the method steps involved. Nevertheless, it should be noted that Stover does teach his apparatus for preparing coffee beverages. In other words, the apparatus of Stover is capable of preparing a coffee beverage.

Applicants argue that the Examiner has failed to provide a basis for customization in Stover and request an affidavit demonstrating same. However, an affidavit is not necessary as the Examiner is relying on the Stover itself for disclosing/teaching an apparatus possessing the ability to prepare a customized coffee product. As referred to above, Stover discloses said apparatus having a dilution dial and that "dilution may be varied so as to vary the strength of the beverage produced" (the paragraph bridging columns 6 and 7). Stover discloses a control knob for changing the water temperature to be used (col. 9, lines 3-7). Stover discloses Clearly, these are all suggestions of ways that the apparatus may be used to customize or provide choices regarding some ingredients or aspects of the coffee beverage produced from same.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 703-308-3846. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
December 4, 2003


12/4/03